

REMARKS

Claims 1-58 stand rejected under 35 USC 103 (a) over US Patent No. 4,866,257 to Elliott et al. (Elliott) in combination with and/or in view of one or more of the following references: US Patent No. 5,736,726 to VanHorn et al. (VanHorn), US Patent No. 5,576,529 to Koenck et al. (Koenck) and US Patent No. 5,801,371 to Kahn et al. (Kahn).

In order to simplify the issues for consideration by the Examiner and in order to secure a quick allowance of the present application, applicants cancel claims 1-8, 17-37 without prejudice or disclaimer. The cancellation of claims 1-8 and 17-37 in no way evidences any intent on Applicants' part to abandon the subject matter of those claims and, indeed, Applicants may choose to pursue claims of lesser, greater, or similar scope and subject matter in subsequent applications related to the present application.

Referring to the rejections in greater detail, the Examiner has rejected claims 9-16, 38, 41-58 under 35 U.S.C. § 103 as being unpatentable for obviousness over Elliott in view of VanHorn.

Claim 9 is directed to a system comprising a nonintegrated processor and reader having a reader processor, wherein a the nonintegrated reader sends a component control instruction to the reader, and wherein the reader processor executes the component control instruction substantially on receipt of the component control instruction from the nonintegrated processor.

Elliott teaches a system comprising a host computer and a scanner. The host computer, in one embodiment, sends "control characters" to an EEPROM memory device 24 of the scanner. As best understood, some time after the "control characters" are sent to the scanner, when the Elliott scanner is used to scan a bar code, the Elliott scanner checks whether the scanned bar code corresponds to the data of the control characters: " The use of EEPROM 24 to store the control characters permits the scanner 12 to be programmed to recognize any desired control characters, and multiple sets of such characters as indicating a pair of labels on a single product" (Elliott, column 4, lines 26-30).

VanHorn, meanwhile teaches a stand alone bar code reader that is not

described as being in communication with any host computer. The VanHorn stand alone reader has a trigger 162, a keyboard 130 a display 135 and an antenna 140.

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants remarks are centered on the first and third of the above requirements for establishing a case of *prima facie* obviousness, namely the requirement that the Examiner must provide an explanation for why a skilled artisan would be motivated to modify a reference or combine references, and the requirement that the prior art must teach or suggest all of the claim limitations.

The Examiner has rejected claims 9-16, 38, 41-58 based on the combination of Elliott and VanHorn. Herein below is the complete statement of the Examiner's reasons for why a skilled artisan would be motivated to combine Elliott and VanHorn:

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of VanHorn et al into the teachings of Elliott et al in order to provide Elliott et al with a more compact and convenient system, wherein the system can be operated easily by one hand (i.e., due to gun style and trigger activation). Furthermore, such modification would provide Elliot et al with a capability of reading high capacity of encoding data (i.e., reading 2D image, which contains more encoded data). Moreover, such modification would provide the user with a greater flexibility in inputting data via keyboard, reviewing output data through the display and knowing whether a good read/scanning has accomplished, and thus providing a more user-friendly system. Accordingly, such modification would have been an obvious extension as taught by Elliot et al, and therefore an obvious expedient.

Analyzing the portions of the above text purporting to establish a motivation to modify Elliott or combine Elliott with VanHorn, applicants submit that the

Examiner has not provided a single bona fide reason for why Elliott and VanHorn are combinable. The Examiner has merely provided a generally stated laundry list of advantages which skilled artisans commonly have in mind in building optical readers and optical reader systems (motivation to make a more compact and convenient system...greater flexibility...a more user-friendly system). It is troubling to consider the harm that would be incurred by inventors everywhere if providing a laundry list of generally stated advantages relative to an art was allowed to pass as a bona fide rationale establishing a motivation to modify or combine. Significantly, BOTH Elliott and VanHorn were strongly motivated to make a more compact and convenient system, with greater flexibility and greater user-friendliness, and yet developed systems which were radically different from each other and radically different from the claimed invention. In purportedly establishing a motivation to combine, the Examiner does not consider a single technical teaching of either Elliott or VanHorn. The generally stated laundry list of advantages relating to optical readers cannot seriously taken to constitute establishing a motivation to combine the teachings of VanHorn with the teachings of Elliott.

In addition to failing to establish that Elliott and VanHorn are combinable, the Examiner has failed to establish that the combination of Elliott and VanHorn satisfies all of the elements of the claimed invention. According to the third requirement for establishing prima facie case of obviousness, as summarized in MPEP 2143, the Examiner must demonstrate that the prior art reference (or references when combined) teach or suggest all the claim limitations. Even if Elliott and VanHorn were combinable (which the Examiner has not established) their combined teachings would not yield the claimed invention.

Regarding claim 9, claim 9 recites in part a reader processor which executes a component control instruction substantially on receipt of the component control instruction.

In conducting an examination the Examiner must "make a *thorough* investigation of the available prior art relating to the subject matter of the *claimed invention*." **MPEP 2260**. Further "when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated *as nearly as practicable*. The pertinence of each

reference, if not apparent, must be clearly explained..." **MPEP 2260** Further, as explained previously, to establish prima facie obviousness based on combined references, the Examiner must demonstrate that the combination teaches all of the elements of claim 9.

In rejecting claim 9 based on the combination of Elliott and VanHorn the Examiner merely states

Elliott et al discloses an optical reader 12 comprising a memory 60 in communication with a processor 18 having program stored thereon for controlling operation of the optical reader 12; the optical reader 12 being adapted to receive a component control instruction from a nonintegrated processor 10, and further being adapted to execute the component control instruction from the nonintegrated processor (fig. 1, col. 3, line 45 through col. 4 line 46).

Applicants have analyzed the long purportedly relevant section of Elliott and fail to see how Elliott can be said to teach or suggest a reader processor which executes a component control instruction substantially on receipt of the component control instruction. The Examiner has not fully considered at least the limitation of a reader processor which executes a component control instruction substantially on receipt of the component control instruction. Because the Examiner has not fully considered at least the limitation of a reader processor which executes a component control instruction substantially on receipt of the component control instruction, the Examiner has not established a case of prima facie obviousness as against claim 9. Because the Examiner has not satisfied his duty to establish a case of prima facie obviousness as to claim 9, claim 9 is allowable over the prior art of record.

In that claim 9 is allowable over the prior art, dependent claims 10-16, 38-58 which depend on claim 9 are allowable at least for the reason that they depend from an allowable base claim.

Because dependent claims 10-16, 38-58 are allowable at least for the reason that they depend from an allowable base claim, it is not necessary for the applicants to provide further arguments as to the patentability of claims 10-16, 38-58. Nevertheless, applicants herein consider certain of the dependent claims for purposes of pointing out additional inadequacies in the Examiner's stated grounds for rejections.

Regarding dependent claim 10, dependent claim 10 recites the component control instruction of claim 9 wherein the component control instruction is a remote

trigger activation instruction. Restating the combined limitations of claim 10 and 9, claim 10 requires a nonintegrated processor which transmits a trigger activation signal to a reader processor which executes the instruction substantially on receipt of the instruction. The Examiner rejects claim 10 based on the combination of Elliott and VanHorn. The Examiner states that the "remote trigger activation instruction" is satisfied by trigger 162 of VanHorn.

As indicated above, in maintaining a prima facie case of obviousness, the Examiner must demonstrate that each and every element of a claimed invention is shown in the prior art. Neither Elliott nor VanHorn, alone or in combination, teach a nonintegrated processor which transmits a trigger activation signal to a reader processor which executes the instruction substantially on receipt of the instruction. VanHorn's trigger 162 cannot seriously be considered suggestive of applicants trigger activation signal for several reasons. Notably, the Examiner has failed to allege that trigger 162 of VanHorn constitutes a processor. By contrast, applicants claim 10 specifically requires that the recited "trigger activation instruction" is sent from a "nonintegrated processor". Further, trigger 162 of VanHorn is effective to send a trigger signal to processor 700 of VanHorn only when handle 145 is integrated to a reader housing ("*Once connected*, the operator may grip the pistol grip gripping portion 150 of the handle 145 like a handle of a pistol and perform a bar code read by depressing the trigger 162", emphasis added, VanHorn, column 6, line 37-40). By contrast, applicants claim 10 specifically requires a that trigger activation signal is sent from an element (a processor) that is nonintegrated relative to a portable reader.

In view of the above, the combination of Elliott and VanHorn, under any fair reading of those references, fails to satisfy all the limitations of claim 10. Accordingly, the Examiner has failed to establish prima facie obviousness to claim 10.

Regarding claim 12, claim 12 recites the system of claim 9 wherein said imaging assembly includes an illumination source and wherein execution of said component control instruction results in said illumination source being controlled. Taking the limitations of claims 12 and 9 together, claim 12 recites a nonintegrated processor which transmits a illumination source control instruction to a reader,

which is executed by a reader processor substantially on receipt thereof to control a light source.

The Examiner makes no effort whatsoever to establish that the combination of Elliott and VanHorn teaches a nonintegrated processor which sends and light source control instruction to a reader which is executed substantially on its receipt by a reader processor. The Examiner simply alleges that VanHorn includes a light source. The statement by the Examiner that VanHorn includes a light source does not constitute an establishing by the Examiner that the combination of Elliott and VanHorn teaches a nonintegrated processor which sends and an illumination source control instruction to a reader which is executed substantially on its receipt by a reader processor to control the illumination source. In order to establish a prima facie case of obviousness as to claim 12, the Examiner must establish that the combination of Elliott and VanHorn teaches a nonintegrated processor which sends and an illumination source control instruction to a reader which is executed substantially on its receipt by a reader processor to control the illumination source. Claim 12 is patentable, in addition to the reasons already provided, at least for the reason that the Examiner has failed to establish that the combination of Elliott and VanHorn teaches a nonintegrated processor which sends and an illumination source control instruction to a reader which is executed substantially on its receipt by a reader processor to control the illumination source.

A prima facie case of obviousness cannot be established by selectively considering certain limitations of a claim and ignoring other limitations of a claim.

Regarding claim 13, claim 13 recites the system of claim 9 wherein said optical reader includes an acoustic output device, and wherein execution of said component control instruction results in said acoustic output device being controlled. Taking the limitations of claim 13 and claim 9 together, claim 13 requires a nonintegrated processor which sends to a portable optical reader an acoustic output control instruction which is executed substantially on its receipt by a reader processor so that the acoustic output is controlled.

The Examiner makes no effort whatsoever to establish that the combination of Elliott and VanHorn teaches nonintegrated processor which sends to a portable optical reader an acoustic output control instruction which is executed substantially

on its receipt by a reader processor so that the acoustic output is controlled. The Examiner simply alleges that VanHorn includes an acoustic output device. The statement by the Examiner that VanHorn includes an acoustic output device cannot seriously be accepted as an establishing by the Examiner that the combination of Elliott and VanHorn teaches a nonintegrated processor which sends to a portable optical reader an acoustic output control instruction which is executed substantially on its receipt by a reader processor so that the acoustic output of the reader is controlled. In order to establish a prima facie case of obviousness as to claim 13, the Examiner must establish that the alleged combination satisfies all, not just some of the elements of the claimed invention. Specifically, the Examiner must establish that the combination of Elliott and VanHorn teaches a nonintegrated processor which sends to a portable optical reader an acoustic output control instruction which is executed substantially on its receipt by a reader processor so that the acoustic output is controlled. Claim 12 is patentable, in addition to the reasons already provides, at least for the reason that the Examiner has failed to establish that the combination of Elliott and VanHorn teaches a nonintegrated processor which sends to a portable optical reader an acoustic output control instruction which is executed substantially on its receipt by a reader processor so that the acoustic output is controlled.

It will be seen that the same analysis can be applied to several of the dependent claims which depend from claim 9.

It was shown with regard to the exemplary dependent claim 10, 12 and 13, that the Examiner, in rejecting certain of the dependent claims, considers certain of the claim limitations, and ignores others.

Regarding dependent claims 14 and 15, however, the Examiner apparently ignores ALL limitations of the dependent claims.

Regarding claim 15, claim 15 specifically recites the system of claim 9, wherein the reader memory stores at least one frame of image data, and wherein execution of said component control instruction results in said at least one frame of image data being uploaded to said nonintegrated processor.

There is no discussion by the Examiner whatsoever regarding the specifically recited limitations of claim 15. The Examiner completely ignores claim 15 and all of its claim elements. The Examiner has failed to establish a prima facie case of obviousness as to claim 15. Claim 15 is, therefore, allowable over the prior art of record for the additional reason that a prima facie case of obviousness has not been established as to any of the limitations recited in claim 15.

Regarding dependent claim 16, claim 16 specifically recites the system of claim 9, wherein execution of the component control instruction results in said reader processor controlling said imaging assembly to capture a frame of image data in said reader memory.

There is no discussion by the Examiner whatsoever regarding the specifically recited limitations of claim 16. The Examiner completely ignores claim 16 and all of its claim elements. The Examiner has failed to establish a prima facie case of obviousness as to claim 16. Claim 16 is, therefore, allowable over the prior art of record for the additional reason that a prima facie case of obviousness has not been established as to any of the limitations recited in claim 16.

Regarding claims 15 and 16 together, the Examiner's attention is drawn to MPEP 706.07 respecting "final rejections." According to MPEP 706.07 a final rejection is in order only where "a clear issue" is developed between the Examiner and the applicant. Before issuing a final rejection, the invention claimed "should be thoroughly searched in the first action and the references fully applied."

If the Examiner wishes to maintain his rejection of claims 15 and 16 he is precluded, under MPEP 706.07 from making that rejection final. The Examiner has not examined either of claims 15 and 16. Therefore the Examiner has not developed any issue regarding the patentability of claims 15 and 16. As stated in MPEP 706.07 it is necessary for an Examiner to develop a clear issue regarding every claim, and to fully apply references to each claim.

The limitations of claim 15 and 16 also appear in claims 47 and 48. The Examiner completely ignores the limitations of claims 47 and 48 as well as the limitations of claims 15 and 16. In addition to the reasons already given, claims 47 and 48 are allowable at least for the further reason that the Examiner has failed to establish a case of prima facie obviousness as to the specifically recited limitations of claim 47 and 48.

Regarding claims 39 and 40, claims 39 and 40 are rejected under 35USC 103(a) over Elliott as modified by VanHorn, and further in view of Kahn.

Claim 39 recites the system of claim 9 wherein the nonintegrated local host processor is adapted so that data is input thereto via a graphical user interface.

Claim 40 recites the system of claim 9, wherein the nonintegrated processor is a local host processor is adapted so that data is input thereto via a graphical user interface, said graphical user interface adapted for use in developing instructions for transmission to said portable reader.

The Examiner states that claims 39 and 40 are obvious over Elliott as modified by VanHorn and further in view of Kahn. The Examiner alleges that Kahn provides the missing teaching of a graphical user interface.

However, that assertion is untenable in that Kahn teaches only a graphical user interface in a free standing reader. By contrast, claims 39 and 40 specifically require a graphical user interface incorporated in a nonintegrated processor which sends a component control instruction to an optical reader which executes the component control instruction substantially on receipt of the component control instruction.

Neither Kahn, nor any of the other references alone or in combination teach a graphical user interface incorporated in a nonintegrated processor which sends a

component control instruction to an optical reader which executes the component control instruction substantially on receipt of the component control instruction.

As indicated previously, in order to establish a prima facie case of obviousness, the Examiner must show that each and every claim limitation is shown or suggested in the prior art. The Examiner has not met that burden regarding claims 39 and 40 in that the Examiner has shown prior art teaching only a GUI incorporated in an optical reader. The Examiner has not demonstrated that the prior art teaches a graphical user interface incorporated in a nonintegrated processor which sends a component control instruction to an optical reader which executes the component control instruction substantially on receipt of the component control instruction.

In rejecting claims 59-64, the Examiner relies on Koenck. Claims 59-64 recite a system comprising an optical reader, and a non-integrated processor which sends to the optical reader a component control instruction which is executed substantially on its receipt by a reader processor to result in a light being flashed (59, 61,63) or series of beeps being emitted (claims 60, 62, 64)

Koenck, relied on by the Examiner, teaches an optical reader which can flash light and emit a series of beeps. However, the processing which results a series of beeps or flashing light being emitted by a Koenck occurs entirely within the Koenck reader.

By contrast, applicants claims 59-64 specifically recite that the flashing light or series of beeps emitted by a reader result from an execution of a component control instruction which is received by the reader from a nonintegrated processor. The Examiner alleges only that the Koenck reader flashes light or emits beeps. The Examiner does not establish, and does not even allege that prior art teaches a system comprising an optical reader, a nonintegrated processor, wherein the nonintegrated processor sends to the reader a component control instruction which is executed

substantially on its receipt by a the reader processor to emit a series of beeps (claims 60, 62, 64) or flash light (claims 59, 61, 63).

In order to establish a case of prima facie obviousness against a patent claim the Examiner must establish that all, not just some of claim's limitations are taught or suggested in the prior art. In order to establish a prima facie case of obviousness against claims 59-64, the Examiner must demonstrates that the prior art teaches or suggests system comprising an optical reader, and a nonintegrated processor, wherein the nonintegrated processor sends to the reader a component control instruction which is executed substantially on its receipt by a the reader processor to emit a series of beeps (claims 60, 62, 64) or flash light (claims 59, 61, and 63).

In addition to the other reasons for allowance provided, claims 59-64 are allowable at least for the additional reason that the Examiner has failed to satisfy his burden of establishing that the prior art teaches or suggests a system comprising an optical reader, a nonintegrated processor, wherein the nonintegrated processor sends to the reader a component control instruction which is executed substantially on its receipt by a the reader processor to emit a series of beeps (claims 60, 62, 64) or flash light (claims 59, 61, 63).

The Examiner will note that the applicants have amended claim 9 to correct for a possible "lack of antecedent basis" informality. In that it does not add or modify any claim elements, the amendment to claim 9 in no way narrows or otherwise affects the scope of claim 9.

Accordingly, in view of the above amendments and remarks, Applicants believe all of the claims of the present application to be in condition for allowance and respectfully requests reconsideration and passage to allowance of the application.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Respectfully submitted,

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"VERSION WITH MARKINGS TO SHOW CHANGES MADE"

In the Claims:

Please amend claim 9 as follows:

9. (Amended) An optical reader system comprising:

a portable optical reader; and

a nonintegrated processor;

[a] said portable optical reader having an imaging assembly, a reader processor in communication with said imaging assembly, and a reader memory in communication with said reader processor, said optical reader being adapted to receive a component control instruction from [a] said nonintegrated processor; [and]

said nonintegrated processor adapted to transmit a component control instruction in response to a user input command to control said optical reader;

said optical reader being programmed so that said reader processor executes said component control instruction substantially on receipt of said component control instruction from said nonintegrated processor.